

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant(s): Jani, et al.

Examiner: Corbin, A.L.

Application: 10/664,426

Group Art Unit: 1761

Filed: August 26, 2003

Docket: 1421-58 DIV/RCE

Confirmation No: 4538

Date: August 15, 2007

For: THREE-LAYERED
CENTER-FILLED GUM PRODUCT
WITH CANDY SHELL

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Sir:

Pursuant to 37 C.F.R. §41.41, Appellants file this Reply Brief in response to the Examiner's Answer of June 15, 2007. Appellants address particular points and continue to rely on the arguments of their main Appeal Brief.

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A. Obviousness Standard

Since the filing of Appellants' main Appeal Brief, the U.S. Supreme Court handed down a decision in *KSR Int'l. Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007). Although the Court noted that the "teaching, suggestion or motivation" test is not to be applied rigidly, it nevertheless remains an important tenant of patent law. The PTO in its own memorandum of May 3, 2007 cautioned the Examining corps:

Therefore, in formulating a rejection under 35 U.S.C. §103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.

With reference to Appellants' previous arguments, the lack of motivation discussed in the main Appeal Brief shows that there is no reason to combine the prior art as suggested by the Examiner. Moreover, as also discussed in the main Appeal Brief, there would be no reasonable expectation of success.

B. Response to Argument

Appellants seek to respond to several statements set forth by the Examiner in the Examiner's Answer.

1. McDonald does not disclose separate gum and hard candy layers

At page 4 of the Examiner's Answer, the Examiner responded to Appellants' arguments regarding the lack of motivation to combine Friello with McDonald. The Examiner admitted that McDonald teaches that the bubble gum partially melts and mixes with the hard candy material. The Examiner argued, however, that:

McDonald also clearly discloses that the bubble gum is disposed in the center of the candy coating and that the candy syrup forms a suitable coating over the intermixed confection, thereby leading to the conclusion that the candy syrup may intermix with the gum as well as coat the gum.

The Examiner is correct in his admission that the bubble gum melts and mixes with the candy material in McDonald. McDonald specifically states that there is a “substantial intermixing” of the sugar candy base and the bubble gum. (McDonald; Col. 1, lines 10-12 and 35-36). McDonald further explains that:

The intermixing occurs while the candy is a heated liquid, saturating the bubble gum material, and forms hardened brittle crystals and areas in and on the bubble gum material when cooled so that a crunchy characteristic results.

(McDonald; Col. 1, lines 36-40). McDonald’s intermixed compositions, including areas of hardened crystals of candy within and on the gum, cannot be said to be separate layers of a gum material and a hard candy material. Rather, this is a mixture of the two different compositions. This format is distinct from Appellants’ claims, which require separate and distinct layers of a gum material and a hard candy material, and not a mixture of a gum material and a candy material.

2. There is no apparent reason to combine the teachings of Friello with McDonald and no reasonable expectation of success

At page 4 of the Examiner’s Answer, the Examiner asserted that:

Once coated, the gum product of Friello will possess water impenetrability thereby contradicting Appellants’ belief that the water impenetrability of the gum base material in Friello could be disrupted.

The Examiner also continued to dismiss Appellants' argument regarding the problems of leaking or moisture migration of the liquid filling of Friello's center-filled gum upon addition of the hard candy material, as taught in McDonald.

In response, the Examiner has misunderstood Appellants' arguments regarding the water impenetrability of the gum base material of Friello. Water impenetrability is desired in Friello to prevent migration of the aqueous, liquid-fill material out into the gum base material surrounding it. This improves the stability and shelf-life of the product. As noted in Friello, its product has an "extended shelf-life." (Friello; Col. 1, line 41). This is a different concern from preventing absorption of external moisture from the atmosphere. Therefore, providing an outside coating on the gum product of Friello has no relevance to the problem of preventing moisture migration of the liquid-filling out into the surrounding gum.

Rather, as argued in Appellants' main Appeal Brief, adding the hot candy material, as taught in McDonald, to the product of Friello is likely to destroy the water-impenetrability of Friello's gum base material, and thus, its ability to prevent absorption of the aqueous, liquid filling. As discussed above, McDonald teaches that, upon dipping, its hot candy syrup melts, softens and "substantially intermixes" with its gum material, thereby forming areas of hardened candy crystals in and on the gum material. These hardened candy crystals are dissolvable, (McDonald; Col. 1, line 45), and water from Friello's liquid-filling would dissolve the candy and in time likely produce leakage. Therefore, the candy material changes the composition of the chewing gum material. McDonald even specifically states that its hard candy intermixes with the gum and "completely alters the taste and feel" of the gum. (McDonald; Col. 1, lines 41-44).

In view of such teachings, one of ordinary skill in the art would not have been encouraged to add the candy material of McDonald to Friello's center-filled gum product. By

way of explanation, leaking and absorption of the filling in liquid-filled chewing gum products has long been a well-recognized problem in the art. *See, e.g.*, U.S. Patent No. 3,894,154 (Col. 1, lines 20-21, Col. 2, lines 33-38); U.S. Patent No. 4,156,740 (Col. 1, lines 30-32); U.S. Patent No. 4,157,402 (Col. 1, lines 10-47); U.S. Patent No. 4,980,178 (Col. 1, lines 33-40); U.S. Patent Publication No. US2006/0051456 A1 (¶¶ [0004] – [0007]). With such well-known concerns in mind, one of ordinary skill in the art would not have been motivated to add any material to Friello's liquid-filled gum product that would risk the stability of the gum, particularly a material that would change the composition, and hence the water impenetrability, of the gum base material. As such, based on one's general knowledge in the field of art, there would have been no reason to combine the teachings of Friello with McDonald. In fact, such a combination would likely be dismissed by one of ordinary skill in the art as contrary to production of a stable center-fill gum, e.g., one that does not leak.

Not only would there have been no reason to combine the teachings of these references, but there would have been no reasonable expectation of success. In view of the well-known problems associated with moisture migration from the center-fill into the surrounding gum discussed above, there would have been no reasonable expectation that a stable product could be achieved by adding the hard candy material of McDonald to the liquid-filled gum product of Friello without the liquid filling being absorbed into the gum. If anything, to do so would create a less stable center-fill and would be contraindicative to one skilled in the art. Therefore, it would not have been obvious to combine the teachings of Friello and McDonald in attempt to achieve Appellants' claimed invention. *See In re Dow Chem. Co.*, 5 U.S.P.Q. 2d 1529,1531 (Fed. Cir. 1988) ("The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure.") (citations omitted).


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C. Conclusion

McDonald fails to disclose or suggest separate chewing gum and hard candy material layers, as set forth in the main Appeal Brief. Moreover, one of ordinary skill in the art would have had no reason to combine the teachings of Friello with McDonald, and further, no reasonable expectation that a successful product could be achieved. It is respectfully submitted that Appellants' claims 22-24 are patentable.

Favorable action is earnestly solicited and the finding of patentability of claims 22-24 is respectfully requested.

Respectfully submitted,



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